

## 28 Decision of Board of Appeals, February 12, 1960

The above identified applications involving the identical legal question are being considered simultaneously on appeal. Each is an application for a plant patent having the customary single formal claim which in each case is directed to an assertedly new variety of rose plant.

In each case descriptions of the plant have appeared in printed publications more than one year prior to the filing of the applications. These have appeared, for one case,

29 in The National Rose Society Annual of England for 1949 and for the other case in The National Rose Society Annual of England for 1954 (the applications were filed in 1958). Photocopies of pages of these Annuals

are of record. In each case there are also catalogues published more than one year prior to the dates of the respective applications. The catalogues have not been made available but are admitted, pages 24 and 23 of the respective briefs, to "add to the information in the Rose Annual a reproduction in color of a color photograph of the variety."

In a paper filed November 19, 1959 in Appeal No. 269-46 requesting consolidation of the two appeals, appellant conceded that "the publications are thoroughly adequate in each instance to identify the plant as the plant in the particular application." A similar statement appears on page 3 in each of the reply briefs.

It may be noted that the various publications were acknowledged by appellant in the oaths accompanying the applications.

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

30 The examiner has rejected the claim in each case on the ground that the printed publications having effective dates more than one year prior to the filing dates of the instant applications constitute statutory bars to the grant of patents on the described varieties of rose plants. The applicable portion of 35 U. S. C. 102(b) reads:

"A person shall be entitled to a patent unless—

\* \* \*

(b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States, . . ."

The examiner held the above provision applicable to plant patents in view of Chapter 15—Plant Patents of the U. S. Code Title 35—Patents, which in section 161 states:

"The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided."

Appellant (bottom of page 13 of brief) recognizes that the plant patent act was "engrafted onto the existing patent laws" and their provisions, except for "greater liberality in the completeness of the disclosure," made applicable to plants. He states:

"There was no intent to change the meaning of the wording such as now included in the quoted paragraph 102 (b), as theretofore applied to patents on articles, machines, methods, and the like. There is no evidence that it was intended that these words were to be interpreted differently in connection with plants."

It is evident from the preceding that appellant does not challenge the point so vigorously stressed by the examiner, namely the applicability of 35 U. S. C. 102(b) to plant patents. The premise of this appeal is simply that a publication describing a plant cannot, no matter how

31 complete, enable anyone to practice the invention (produce the plant); consequently such publication can never bar a plant patent under 35 U. S. C. 102(b). This result is said to follow from a consideration of the standard applied in patents for inventions, namely that in order to defeat such patents the printed publication advanced as a bar must be sufficient to enable one skilled in the particular art concerned to practice the invention, i.e., to produce the final useful result; *Wisconsin Alumni Research Foundation v. George A. Breon & Co.*, 30 USPQ 242, 85 F. (2d) 166, CCA 8 (1936); *Dewey & Almy Chemical Co. v. Mimex Co., Inc.*, 52 USPQ 138, 124 F. (2d) 986, CCA 2 (1942); or knowledge of the article describing would teach a skillful mechanic some process of making it; *Cohn v. Corset Co.*, 93 U. S. 366, 23 L. Ed. 907 (1876); *In re Schaeffer*, 2 App. D. C. 1, 8 (1893). Since neither of these requirements is met by a published description of a plant it is contended such publication must by application of the same standard be held insufficient to bar the grant of a patent on the plant.

The examiner, while not seriously challenging the appellant's premise that a plant description cannot enable anyone to produce the plant (nor do we see any reason for questioning this premise), states that the language of the statute must be taken in its exact and unequivocal meaning otherwise the anomaly arises that plant publications must be totally ignored as printed publications. In fact, it would have the effect of wholly eliminating that particular provision from 35 U. S. C. 102(b) in the case of plant patents. The examiner further maintains that a prior description of an existing plant adequate to identify the plant  
32 claimed would negative patentable novelty as not "a distinct and new variety" (35 U. S. C. 161).

As indicated by his reply brief the most that appellant would concede with respect to the effect of such publication is that it might constitute secondary evidence of the *prior existence* of the actual plant and *sale* thereof so as to constitute a statutory bar. He further suggests that this

secondary evidence could almost be accepted with little or no corroboration because the chances of any fraud on the public are extremely remote. As has been stated the use or sale of the plants in a foreign country would be irrelevant.

Appellant contends it is absurd to hold that in one case (mechanical) a disclosure must be an enabling disclosure while in another (plant) it need not be. The examiner's "strict literal interpretation" above is (page 13 of brief) alleged to defeat the intent of the plant patent law which is to reward practical results and perpetuate the thing patented after expiration of the patent. Since no one could produce the plant from a written description it is alleged that this result can be assured only by grant of a patent which in turn would encourage the inventor to distribute the plant widely and thereby minimize the possibility of its loss or destruction. With respect to the remark concerning absurdity, it is no more absurd to use a disclosure which is not enabling as a bar than it is to grant a patent on such a disclosure; the disclosure in the specifications of these applications are admittedly just as unenabling as the disclosures of the publications as page 9 of the brief states that:

33 "The teaching in plant patent cases . . . cannot enable anyone, even the most skillful of plant breeders, to produce the particular plant."

Upon consideration of the issue here presented we have come to the conclusion that the examiner must be sustained. Concerning the alleged need for an enabling disclosure to constitute an anticipation, we direct attention to the fact that in the case of claims to an article (or compound), which a claim for a plant is admitted (page 8 of brief) to be most nearly like, disclosure of an operative method of making such article is not essential to constitute an anticipation. On this point we think appellant has misinterpreted the case law. *Cohn v. U. S. Corset Co.*, *supra*, relied upon by appellant did not require in the reference a

teaching of how to make the article. The Court of Appeals of the District of Columbia in the later decision *In re Decker*, 1911 C. D. 274, 162 O. G. 999, 36 App. D. C. 104, quoted *Cohn v. U. S. Corset Co.* as authority for the proposition that the inoperativeness of the reference procedure was immaterial to a consideration of the patentability of the article. A complete description of the article in the reference was held to be all that was required to defeat claims to such article. This ruling was followed in *In re Marden & Rentschler*, 18 CCPA 1119, 1931 C. D. 334, 409 O. G. 561, 48 F. (2d) 428, 8 USPQ 515, in an application involving claims for a ductible thorium wire.

That this principle remains controlling law will be evident from the more recent decisions. See for example *In re Attwood*, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184, involving claims to U-

shaped metallic channel member as a concrete insert.

24 The Court of Customs & Patent Appeals there stated:

"... it is well settled that where the article claimed is disclosed in a prior patent, the claim may be rejected on that patent notwithstanding the fact that the process by which the patentee claimed the product could be produced is inoperative. *In re Marden and Rentschler*, 18 C. C. P. A. (Patents) 1119, 48 F. 2d 428, 8 U. S. Pat. Q. 515; *In re Von Bramer et al.*, 29 C. C. P. A. (Patents) 1018, 1024, 127 F. 2d 149, 53 USPQ 345. Clearly, appellant can stand in no better position where the patentee discloses no process for making the article claimed or where appellant can not discern from the patent disclosure how to construct the article as disclosed."

In *In re Crosley et al.*, 34 CCPA 882, 1947 C. D. 216, 600 O. G. 172, 159 F. (2d) 735, 72 USPQ 499, the same court stated:

"Furthermore, this court is committed to the doctrine that where a product is clearly disclosed in a

publication, the operativeness of any of the processes by which it is claimed the product could be produced is immaterial, and that the disclosure of the composition is sufficient to anticipate a claim therefor."

The U. S. Court of Appeals, District of Columbia Circuit still follows the same rule. See for example *Merck & Co., Inc. v. Marzall*, 1952 C. D. 35, 661 O. G. 576, 197 F. (2d) 206, 93 USPQ 355, wherein this court stated:

"We are dealing solely with an application for a patent on the compound itself. Such an application must be denied if there has been any prior disclosure of the compound, even though no practical means for its isolation or manufacture was previously known. *R. S. 4886*, 35 U. S. C. § 31; *Eastman Kodak Co. v. Coe*, 78 U. S. App. D. C. 403, 135 F. (2d) 836."

Since appellant has admitted that the reference publications in these cases adequately identify the claimed plants it follows from these holdings that the appealed claims were properly rejected regardless of the question of sufficiency of the reference disclosures as to how to produce the plants. The decisions demonstrate that there is no inconsistency in this instance between what properly constitutes a publication under 35 U. S. C. 102(b) in mechanical cases (patents for inventions) and the examiner's application of the references to the claims in the instant plant patent cases.

The decision of the examiner is affirmed.

AFFIRMED

L. P. McCANN )  
Examiner-in-Chief )

P. J. FEDERICO )  
Examiner-in-Chief )

N. A. ASP )  
Examiner-in-Chief )

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